

REMARKS/ARGUMENTS

Applicants thank the Examiner for his consideration of the application. Claims 1-4, 6, 9-17, 20-22, 26 and 29-30 remain pending in the application. Claims 1, 14 and 29 are amended herein.

35 U.S.C. § 102 Rejections

The Examiner rejected claims 1-4, 6, 9-14, 16-17, 20, 26 and 29-30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,541,429 issued to Prosl et al. ("Prosl"). Independent claim 1 is directed to a valve for an implantable fluid delivery system and independent claim 29 is directed to a fluid switch for an implantable fluid delivery system. Both systems include, among other things, an internal magnet disposed within a fluid chamber and having a movement axis and a magnetic momentum vector axis, the internal magnet movable in at least two directions, one direction along the movement axis and one direction such that the magnetic momentum vector axis is changed, the internal magnet being moveable such that displacement of the internal magnet restricts the flow of fluid through the fluid chamber.

Prosl does not disclose, teach or suggest an internal magnet movable in at least two directions, one direction along the movement axis and one direction such that the magnetic momentum vector axis is changed. The Examiner states that the device of Prosl allows for rotational movement of the internal magnet because the magnet is sealed but free to rotate about the axis. However, amended claims 1 and 29 require that the movement in the second direction changes the magnetic momentum vector axis. Thus, even if the internal magnet of Prosl was able to rotate within the flat cylindrical can (which Prosl never discloses, teaches or suggests

how this may be done), the movement would not change the magnetic momentum vector axis of the internal magnet.

The Examiner, once again, claims that Prosl discloses an internal magnet that “is spherical in width and cylindrical in height.” Office action date November 27, 2006 at 3. *See* also, Office action dated February 17, 2006 at 3. Applicants respectfully disagree. Though all cylindrical shapes are *circular* in one dimension, Prosl does not disclose, teach or suggest an internal magnet that is *spherical* in shape. In fact, Prosl discloses that the internal magnet is a very small “wafer-like” magnet. *See, e.g.*, col. 5, line 45. A wafer-like shape is *not* spherical in shape. The Examiner also claims that Prosl discloses an internal magnet that includes grooves citing element 66 of Prosl in support for this statement. However, Prosl discloses a flat cylindrical can 52 with a magnet 54 hermetically sealed within the can by a discoid cover 56. *See, e.g.*, col. 5, lines 39-48. Prosl does not disclose, teach or suggest that the magnet 54 have any grooves. The parallel spiral slits 66a, 66b, and 66c that the Examiner claims are grooves are not in the magnet 54. Rather, the spiral slits 66a, 66b, and 66c, are formed in the upper spring 62 creating three generally parallel flat spiral cantilevered spring arms 67 which extend from the housing wall and the valve member. *See, e.g.*, col. 5, line 54 – col. 6, line 13. In addition, Prosl does not disclose, teach or suggest that the magnet 54 is coated with any kind of material. Indeed, since the magnet is hermetically sealed within the can, there is no disclosure, teaching or suggestion that this would be beneficial or necessary.

35 U.S.C. § 103 Rejections

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Prosl. The Examiner rejected claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable

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over Prosl in view of U.S. Patent Appl. No. 2002/0108623 issued to Rehder et al. ("Rehder").

As mentioned above, claims 15, 21 and 22, which depend from claim 1, either directly or indirectly, are patentable over the cited prior art, either alone or in combination, for at least the same reasons set forth above with respect to claim 1.

CONCLUSION

Applicants respectfully request that the Examiner consider the Information Disclosure Statement (IDS) filed on February 28, 2006 and the Supplemental IDS filed on May 17, 2006. Both IDS' have been received by the U.S. Patent and Trademark Office as shown in the electronic file wrapper in the Patent Application Information Retrieval (PAIR) section of its website. A copy of the IDS' with the Examiner's initials next to the references cited is requested to show evidence that the Examiner has considered the IDS'.

Enclosed is a petition for a one month extension of time. Please charge Deposit Account No. 19-4972 the required fee of \$120.00 as set forth in 37 C.F.R. §1.17(a)(1). Applicants believe that no additional fees are due at this time. If any additional fees are required for the timely consideration of this application, please charge deposit account number 19-4972.

All the claim rejections have been addressed and all of the pending claims are allowable for the reasons stated and others. Reconsideration of the application and issuance of a notice of allowance are respectfully requested.

Respectfully submitted,

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